

### ARGUMENTS/REMARKS

Applicant has reviewed the above-identified patent application in light of the Office Action having a mailing date of April 15, 2010. In view of the amendments and arguments presented herein, Applicant respectfully submits that the claims are in condition for allowance.

#### **New Claims**

Claims 24-39 have been added to expedite examination.

The Examiner has issued a non-statutory double patenting rejection based on U.S. Patent No. 6,675,406 to Ball (Ball '406). The new claims employ claims language similar to that of Ball '406 that the Examiner found patentable over the same prior art at issue here—Gebert, Fritz and Ball '241.

Therefore, as Claim 24 is similar to Claim 1 of Ball '406 and Ball '406 was patentable over the prior art of record, Claim 24 should be patentable over Gebert, Fritz and Ball '241. Claims 25-35 are believed to be allowable as they ultimately depend from Claim 24.

New independent Claim 36 is directed to a method similar to Claim 11 but that employs elements similar to those of Claim 24. Claims 37-39 are dependent on Claim 36 and are thus believed to be allowable.

#### **Interview Summary**

On June 24, 2010, an interview was conducted between Examiner Fetsuga, Mr. Michael Rasmussen, an associate of the undersigned, and the undersigned. Applicant initially asserted that the rejected claims are not obvious in view of any combination of references that includes Gebert, as Gebert does not disclose a nut having at least one lug (Claim 11) or a plurality of lugs (Claim 21). The Declarations filed with the Amendment and Response of December 14, 2009 and April 15, 2010 were also discussed. The Examiner indicated that the case was still open and the claims could be amended to distinguish the prior art.

### **Summary of Rejections**

Claims 11, 12, 14 and 21-23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Gebert and Fritz. Claims 13 and 15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Gebert, Fritz and Ball '241. Claims 16-20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Gebert, Fritz and further in view of Ball '931 and Ball '241. Claims 11-13, 15, 21 and 22 have been rejected 35 U.S.C. §103(a) as being unpatentable over Gebert and Ball '241. Claims 11-15 and 21-23 have been rejected 35 U.S.C. §103(a) as being unpatentable over Gebert, Ball '241 and Espey. Claims 16-20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Gebert and Ball '241, taken either with or without Espey, and further in view of Ball '931. Claims 21 and 22 have been rejected on the ground of nonstatutory obviousness-type double patenting in view of Ball '406. Claim 23 has been rejected on the ground of nonstatutory obviousness-type double patenting over a combination of Ball '406 and Gebert. Claims 11-13 and 15 have been rejected on the ground of nonstatutory obviousness-type double patenting over a combination of Ball '406 and Ball '241. Claim 14 has been rejected on the grounds of nonstatutory obviousness-type double patenting over a combination of Ball '406, Ball '241 and Gebert. Claims 16-20 have been rejected on the grounds of nonstatutory obviousness-type double patenting over a combination of Ball '406, Ball '241 and Ball '931.

Claims 1 and 21 have been amended. Claims 24-39 have been added. Claims 11-39 are pending.

### **Nonstatutory Obviousness-type Double Patenting**

Claims 11-13, 15, 14 and 16-22 have been rejected under the judicially-created doctrine of nonstatutory obviousness type double patenting as being unpatentable over Ball '406", alone or in view of other references. In order to address this rejection and to expedite prosecution, enclosed is a terminal disclaimer. The filing of a Terminal Disclaimer to obviate the obviousness-type double patenting rejection is not an admission as to the propriety of the rejection. The "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." Quad Environmental

Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

### **Claim Rejections 35 USC §103 - Gebert and Fritz**

The Examiner has rejected Claims 11, 12, 14 and 21-23 as being obvious in view of a combination of Gebert and Fritz. Applicant traverses this rejection because the combination of Gebert and Fritz does not meet *prima facie* obviousness. The combination of Gebert and Fritz does not disclose using a nut element having “at least one lug” (Claim 11) or “a plurality of lugs” (Claim 21). Nevertheless, Claims 11 and 21 have been amended to more succinctly claim embodiments of the present invention that employ a nut element and lugs that constitute a “single-piece” unit. The specification has been amended to provide antecedent basis for this amendment. No new matter has been added to the claims or the specification as the single-piece nut/lug combination is supported by the claims previously of record and in the drawings. In addition, Claims 11 and 21 have been amended to include a positive recitation of threads.

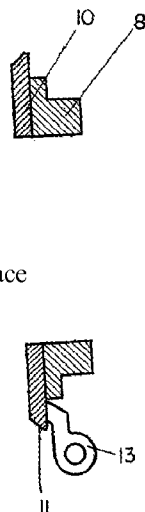
With respect to Claim 11, Gebert does not disclose a nut element having at least one lug wherein the nut element and the at least one lug constitute a single-piece unit. Similarly, with respect to Claim 21, Gebert fails to disclose a nut element with a plurality of lugs that constitutes a single-piece unit. Provided below is a figure showing the claimed nut element of the instant application (right), in comparison with Gebert<sup>1</sup> (left) showing a nut and adapter ring.

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<sup>1</sup> Features not relevant to the following discussion have been removed from the Gebert figure.

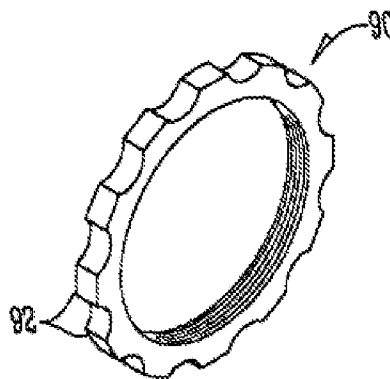
### GEBERT

8 – Nut  
10 – Adapter Ring  
11 – Retaining Surface  
13 – Eyelet



### BALL

90 – Nut  
92 – Lugs



Page 2 of Gebert states:

“[b]etween the wall 7 and the nut 8, there is clamped an adapter ring 10, which is preferably metallic, and whose periphery is provided with a retaining surface 11, having the shape of a truncated cone. The outer edge 12 of the corner is rounded.”

In addition, Gebert does not disclose that the wall of a bathtub is positioned between a lip of an overflow pipe and a nut element. Instead, the “adapter ring 10” (**not** a “nut element”) of Gebert is associated with the bathtub wall. Gebert does not disclose a threaded nut element having lugs that constitutes a single-piece unit, where the radially extending lugs engage the cap. Instead, Gebert discloses notches located on an adapter ring 10. The nut 8 of Gebert does not have lugs for engaging a cap.

Furthermore, the adapter ring 10 of Gebert would not be understood to be a “nut” element by one of skill in the art. The primary requirement of any nut is that it employs internal threads that selectively interface with an externally threaded object.<sup>2</sup> The adapter ring 10 of Gebert does not employ threads that interface with its external threads 4. Gebert also teaches away from employing an adapter ring 10 with threads because a threaded connection between the adapter ring 10 and the overflow pipe would affect the positioning of the eyelet 13<sup>3</sup>. In re Grasselli, 713 F.2d 731 (Fed. Cir. 1983). Put another way, if the

<sup>2</sup> Nut – “A small block of metal or wood with a central, threaded hole that is designed to fit around and secure a bolt or screw.” The American Heritage® Dictionary of the English Language, Fourth Edition, 2009.

<sup>3</sup> Page 2 of Gebert states: “On the adapter ring, there is rigidly mounted an eyelet 13, which is intended for the attachment of a chain, provided with a shut-off stopper or peg for the discharge of the bathtub.”

adapter ring of Gebert were threaded, an installer would have to particularly orient the adapter ring onto the overflow pipe before tightening so that the eyelet would be in a downward position to receive a chain after it is tightened against the bathtub wall. To facilitate prosecution and to further distinguish Claims 11 and 21 from Gebert, those claims have been additionally amended to claim threads on the upper end of the overflow pipe and on the nut element.

The claims also require that the cap be interconnected to the lugs of the nut element. The cap of Gebert, however, interconnects to the adapter ring 10. Gebert's cap is neither "detachably engagable" nor "selectively interconnected" to the lugs of a nut, as is required by Claims 11 and 21, respectively. The Examiner admits this fact on page 10 of the Office Action that states: "cap 14 of Gebert is not connected directly to the nut 8."

It is thus respectfully requested that all rejections of claims based on Gebert be withdrawn.

Withdrawal of the rejection is also requested as the claimed invention enjoys a date of conception that predates the filing date of Fritz, and the requisite diligence existed from the date of conception until constructive reduction to practice (i.e., filing date of the parent '724 application and applications related thereto).

More specifically, Declarations of inventor Ball and witness Carlson were previously submitted to show a conception date prior to Fritz and the requisite diligence. The Examiner has pointed to various alleged deficiencies of those Declarations. The Declarations now submitted herewith are believed to address the issues identified by the Examiner. Specifically, 1) Exhibit A has been annotated to show the plurality of lugs of Claim 21; 2) the Declarations have been amended to now affirmatively recite that both the method of Claim 11 and the apparatus of Claim 21 were conceived in November of 2009, the method being constructively reduced to practice on June 13, 2000 when the parent application was filed; 3) Exhibit A has been annotated to show the membrane; and 4) the Declaration of Mr. Carlson has been amended to state that Mr. Ball disclosed the invention to him in November of 1999.

The combination of Gebert and Fritz is not sufficient to render claims *prima facie* obviousness because Fritz is not prior art. Withdrawal of the rejection to Claims 11, 12, 14 and 21-23 is respectfully requested.

### **Claim Rejections 35 USC §103 - Gebert, Fritz and Ball ‘241**

The Examiner rejected Claims 13 and 15 as being obvious in view of a combination of Gebert, Fritz, and Ball ‘241. For the reasons outlined above, Applicant asserts that Fritz is not prior art that can be combined with Gebert and Ball ‘241. The combination of Gebert and Ball ‘241 does not include each of the elements claimed as the Examiner admits that Gebert does not disclose a fluid flow prevention means. Applicant also incorporates the arguments provided above related to Gebert, including the failure of Gebert to disclose a threaded nut that has lugs that engage a cap.

Accordingly, Claims 13 and 15 are believed to be allowable and withdrawal of this rejection is respectfully requested.

### **Claim Rejections 35 USC §103 - Gebert, Fritz, Ball ‘931 and Ball ‘241**

The Examiner rejected Claims 16-20 as being obvious in view of a combination of Gebert, Fritz, Ball ‘931, and Ball ‘241. For the reasons outlined above, withdrawal of this rejection is requested as Fritz is not prior art that can be properly combined with Gebert, Ball ‘931 and Ball ‘241. In addition, this combination of references does not include each of the elements claimed, e.g., see arguments presented above with respect to Gebert including the failure of Gebert to disclose a threaded nut that has lugs that engage a cap.

Accordingly, Claims 16-20 are believed to be allowable and withdrawal of this rejection is therefore requested.

### **Claim Rejections 35 USC §103 - Gebert and Ball ‘241**

The Examiner has rejected Claims 11-13, 15, 21 and 22 as being obvious in view of a combination of Gebert and Ball ‘241. Applicant traverses this rejection because the combination of Gebert and Ball ‘241 does not meet the *prima facie* test for obviousness.

Applicant incorporates arguments presented above with respect to Gebert including the failure of Gebert to disclose a threaded nut that has lugs that engage a cap. Ball ‘241 does not disclose the use of a nut element with a plurality of lugs.

Accordingly, Claims 11-13, 15, 21 and 22 are believed to be allowable and withdrawal of this rejection is therefore requested.

### **Claim Rejections 35 USC §103 – Gebert, Ball ‘241, Espey, and Holt**

The Examiner has rejected Claims 11-15 and 21-23 as being obvious in view of a combination of Gebert, Ball ‘241, Espey, and Holt. Applicant traverses this rejection because the combination of Gebert, Ball ‘241, Espey and Holt does not meet the *prima facie* test for obviousness.

The Examiner admits that Gebert fails to disclose a fluid prevention means. As outlined above Gebert does not disclose the claimed nut element. In addition, Holt does not disclose a nut element having “at least one lug” (Claim 11) or “a plurality of lugs” (Claim 21). Holt discloses a prior method of associating an overflow pipe with a bathtub wherein a sleeve or housing 40 is used that receives a covering 60.

Applicant specifically traverses the Examiner’s assertion that Espey cures the deficiencies of Gebert, as Espey is not analogous prior art that one of skill in the art would be motivated to combine with Gebert and Ball ‘241. One of skill in the plumbing arts would not be motivated to review the bicycle arts, to which Espey belongs. More specifically, two criteria are relevant in determining whether prior art is analogous: “(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” Comaper Corp. v. Antec, Inc., 596 F.3d 1343, 1351 (Fed. Cir. 2010) (quoting In re Clay, 966 F.2d 656, 658-59 (Fed. Cir. 1992)). Again, Gebert and Espey do not belong to the same field of endeavor and Espey is not pertinent to the particular problem addressed by the claims – to conceal a nut associated with an overflow port.

Moreover, Espey fails to disclose the claimed “cap.” Espey shows a “sleeve” 40, that is positioned over a nut 20 that is associated with a fork shaft 12 of a bicycle to protect the rider from being injured by the sharp edges and corners of the nut 20 (Col. 1, line 26). The feature 40 shown in Espey has an open top through which a handle bar rod 14 extends

(see Figs. 1 and 3). Espey therefore discloses a “sleeve<sup>4</sup>” that fits over a nut – as contrasted to the “cap<sup>5</sup>” as set forth in the present claims.

The Examiner has not provided the requisite rational that would lead one of skill in the art to combine Espey, Gebert, Ball ‘241, and Holt. More specifically, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006). Here, the Examiner admits that Gebert fails to disclose a fluid prevention means. Gebert also fails to disclose a threaded nut having lugs that engage a cap. Espey discloses an open-top sleeve for protecting a bike rider, not a cap that engages with lugs on a threaded nut. Further, the Examiner has provided no support that one of skill in the art would see Espey’s method of interconnection as equivalent or an obvious variant to the claimed interconnection method. It is believed that the Examiner is using impermissible hindsight to make such a statement as, prior to the Applicants’ discovery, it was common to associate the overflow cover with an adapter ring as disclosed by Gebert or a sleeve as disclosed by Ball ‘241 and Holt.

Furthermore, the “lugs” 21-26 of Espey are not detachably engaged (Claim 11) nor are they selectively interconnected (Claim 21) to the inner surface of a cap as claimed. Rather, Espey’s cap is fitted to a nut by pressing downwardly such that the projections 52 snap into slots 33. See Figs. 2 and 3 of Espey provided below.

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<sup>4</sup> Sleeve – “a tubular piece, as of metal, fitting over a rod or the like.” The American Heritage® Dictionary of the English Language, Fourth Edition, 2009.

<sup>5</sup> Cap – “anything resembling or suggestive of a covering for the head in shape, use, or position: a cap on a bottle.” The American Heritage® Dictionary of the English Language, Fourth Edition, 2009.





for obviousness as outlined above. That is, Claims 16-20 depend on Claim 11 and are thus believed to be allowable for the reasons Claim 11 is believed allowable, as argued herein.

### **Interview Request**

To facilitate prosecution, it is requested that an interview be conducted prior to substantive review of the amendments presented herein. As shown on the enclosed Applicant Initiated Interview Request Form, the attendees for this interview should be Joseph Kovarik of Sheridan Ross P.C., Examiner Fetsuga and Supervisory Examiner Gregory Huson and the undersigned. A tentative date for this interview is set for Wednesday, September 22, 2010 at 3:00 p.m. E.S.T., 1 p.m. M.S.T. It is understood that the Examiners may suggest a different date and time for this interview. It is hoped that such an interview will assist in avoiding further prosecution of the instant application as the claims as previously presented and now amended are believed to be allowable as outlined herein.

### **Conclusion**

Applicant respectfully traverses the remainder of the Examiner's assertions as to what is disclosed and/or taught by the cited prior art. That is, as the amendments and arguments made herein are believed to address the rejections, any Examiner assertions not specifically addressed are not admitted as true. Furthermore, any arguments concerning motivation to combine, etc. not specifically put forth are not waived.

Applicant submits that at least the new claims now presented are clearly in a condition for allowance because of the similarity of such claims with a previously issued claim and in view of the presently submitted Terminal Disclaimer. Such previously issued claims were deemed patentable over the principal references now at issue in the present case. As such, Applicant respectfully submits that the new claims, as well as all of the currently amended claims, are also patentable over such references.

In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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